

### **REMARKS**

Claims 1-30 are pending in the application. Original independent claim 1, dependent claims 2-14 and previously presented dependent claims 15-16 are retained. New claims 17-30 are presented. New independent claim 18 is based upon previously presented claim 16 calling for a securement to maintain a first end of a gasket partially collapsed but eliminates some of the elements of claim 16. New independent claim 22 is based upon original claim 12 but also has part of the original language of claim 12 removed.

In the final Office Action mailed June 29, 2005, original claims 1-5, 9 and 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,205,075 (“Moyer”) in view of U.S. Patent No. 767,763 (“Reinvaldt”); claims 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Moyer in view of Reinvaldt in further view of U.S. Patent No. 4,986,033 (“Weil”); and claims 1-5 and 10-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Moyer in view of U.S. Patent No. 4,156,533 (“Close *et al*”)

#### **Claim Rejections – 1-5, 9, 15-16 based upon Moyer and Reinvaldt**

Applicants traversal of the rejections based upon Moyer and Reinvaldt is repeated because those rejections were not withdrawn in the final Office Action even though they were *prima facie* unsupported.

The Examiner states that Reinvaldt further discloses a gasket having a first male end F, a female end G and two fasteners C adjacent the ends that hold a joint formed by the male and female ends (Fig. 4). The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the first and second ends of Moyer to be a male end and a female end, respectively, as taught by Reinvaldt, to provide a joint without a lump (page 1, column 2, lines 75-85 of Reinvaldt) or an alternative way of joining a member to form a loop. Applicant respectfully traverses the characterization of Reinvaldt and the rejection.

Moyer is directed to an oven gasket 90 and clips 10 used to mount the oven gasket 90 to an oven door 150. The gasket 90 includes an inner tubular support number 110 and an outer braided sealing member 100 made of braided fiberglass (col. 5, lines 14-40). The gasket 90 is a

continuous loop and the clips 10 are spaced along the gasket 90 only according to the spacing of holes 160 in the oven door 150 (Fig. 11). Nothing is said about a joint, how such joint is or would be constructed or held together.

Reinvaldt is directed to a “soft metal” gasket for flange couplings that is cast in one piece. The metallic gasket includes tapered entering ends F and enlarged receiving ends G so that one may enter the other and also to avoid a lump and corresponding looseness of the joint (column 2, lines 72-84). The ends F, G are held together by being crushed between flange faces E “so tightly . . . that the yielding metal fills up all the minute irregularities of the harder surfaces E . . . (and which ) causes the tin to flow into and fill up whatever space is left between the stem of the bolt and the walls of the holes C . . .” (Reinvaldt page 1, lines 51-64.)

Initially, the Examiner’s characterization of Reinvaldt “holes C” as fasteners is unsupported. While the Examiner is given broad latitude in construing claim language, especially where vague, he does not have a license to invent new definitions and meanings. The claims calls for a plurality of fasteners and separately for a plurality of openings. The holes C of Reinvaldt correspond to the openings. Reinvaldt, however, discloses only one fasteners, a bolt D.

It is also submitted that the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end are clearly structural features of the present invention and are not method limitations as stated by the Examiner.

Referring to MPEP 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference “or references when combined” must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

Applicant submits that Moyer and Reinvaldt are not properly combinable under 35 U.S.C. § 103. Moyer is directed to a flexible gasket 90 made of braided fiberglass. Reinvaldt, on the contrary, is directed to a solid metallic gasket that is cast in one piece (lines 30-35) and held together by having its ends crushed together. There is no teaching or suggestion in Moyer that metallic gaskets could be used in place of braided fiberglass gaskets. The “casting” and “swagging” construction of Reinvaldt is not suited for use on a resiliently flexible tribular wall like that of Moyer. The braided fiberglass cannot be thinned to avoid the creation of a lump of a joint and will not “flow” under pressure, even extreme pressures, to effectively drive excess gasket material out of a joint. Reinvaldt’s benefits are achieved by the nature of the gasket material being employed, a ductile metal that can be thinned, formed into a shape that will be held (swagged down or expanded), and flow when subjected to the pressure used to create the seal being made. The oven gasket of Moyer shares none of these capabilities.

Moreover, any reasonable expectation of success must come from the prior art itself. Nothing in the prior art teaches or suggests that the particular construction of Reinvaldt can be duplicated with fiberglass gasket material of Moyer. More particularly, if one Moyer gasket end were expanded as taught by Reinvaldt, there is no way to predict from either reference if it could again be successfully reduced in size to avoid the creation of a lump. The oven gasket will not be subjected to the pressures that the Reinvaldt gasket is subjected to (enough to make the metal flow). Any teachings or suggestion of the possible success of the use of the Reinvaldt construction in a fiberglass oven gasket is taught or suggested by the present application. Thus, a *prima facie* case of obviousness cannot be made. There is no teaching or suggestion to combine the two references or teaching or suggestion as to how Moyer could be constructed to secure the benefits of Reinvaldt and no teaching or suggestion that the successes and benefits of the Reinvaldt construction in ductile metal can be duplicated with braided fiberglass.

Even if Moyer and Reinvaldt were combined for argument sake, the combination would still fail to disclose the element of original claim 1 of “...the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings.” In the present invention, the joint 80 formed by the joining of the first and second ends 10a, 10b is actually held together by the fasteners 20’ securing the gasket to the oven door or face. The fasteners 20’ are strategically placed on each side of the joint and received in

two of the spaced openings 160. This is so that the joint 80 is held in place. In Moyer, there is no mention of first and second ends of the gasket. Furthermore, there is no mention of specific placement of the clips 10. As seen in Fig. 4, the clips 10 are placed along the gasket 90 only based on the location of the holes 160 of the oven door 150 (col. 7, lines 24-28). Reinvaldt only discloses two ends of a metallic gasket being joined by frictional or fused fit. There is no mention of fasteners immediately adjoining each of the first and second ends of the wall received in two spaced openings. Thus, a *prima facie* case of obviousness cannot be met since there is no teaching or suggestion of the above-quoted novel feature of original claim 1 even if Moyer and Reinvaldt were combined.

These arguments apply equally to the rejection of claims 2-4, 9 and 15-16. Moreover, some of the rejections are traversed on additional grounds.

The rejection of claim 4, in particular, is traversed as it calls for the plurality of fasteners to be formed by one wire (a single continuous wire) not a plurality of wires. Moyer's entire invention is a new form of spring clip fastener made from a separate and individual short length of wire.

Claim 16 calls for "a securement mounted (sic) the first (sic) as to maintain the first end in a partially collapsed condition even with the first end separated from the second end." Neither references teaches or suggests such a securement mounted to the first end.

Applicant further respectfully traverses the rejection of original claims 6-8 under 35 U.S.C. 103(a) as being unpatentable over Moyer and Reinvaldt as applied to the claims above, and further in view of U.S. Patent No. 4,986,033 (Weil). The Examiner does not rely upon Weil to overcome the infirmity of the proposed combination of Moyer and Reinvaldt and Weil says nothing about any joint.

**Claim Rejection – 1-5 and 10-14 based upon Moyer and Close *et al***

The Examiner has also rejected claim 1 and dependent claims 2-5 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over Moyer as applied above and further in view of Close *et al* U.S. Patent No. 4,156,533. With respect to claim 1, the Examiner asserts that Moyer discloses the invention substantially as claimed but admits that Moyer fails to disclose that the first end of

the flexible wall is at least partially collapsed to form a male end and that the second end of the wall is left uncollapsed to form a female end. The Examiner further admits that Moyer does not disclose that the male end is adjustably received within the female end to form a joint engaging the first and second ends together to form the closed loop. The Examiner states that Close *et al.* discloses a gasket having a core 40, an outer jacket 42, a male end (end of the core 40 in Fig. 6) and a female end (end of the outer jacket 42) where the male end is inserted into the female end to form a joint. The Examiner further states that an end (end on the left side of Fig. 6) of the core 40 extends beyond an end (and on the left side of Fig. 6) of the outer jacket 42 and an end (and on the right side of Fig. 6) of the outer jacket 42 extends beyond an end (and on the right side of Fig. 6) of the core 40. The Examiner argues that it would have been obvious to one having ordinary skill in the art the time the invention was made to configure the first and second ends of Moyer to be a male end formed by the core and a female end formed by the outer jacket, respectively, as taught by Close *et al.*, to provide a gasket that is continuous (column 3, lines 56-62 of Close *et al.*) or an alternative way of joining a member to form a loop. Applicant respectfully traverses the rejection.

Close *et al* is directed to a high temperature gasket having a core, an outer wall and first and second ends. On the first end, core material 40 is moved forward from outer wall 42. On the second end, the outer wall 42 is moved forward from the core material 40 (Fig. 6). The first end is inserted into the second end to form a joint 44 (Fig. 7). An additional piece of sheathing 46 can be included to further strengthen the joining 44 (Fig. 8).

It is initially submitted that the first end of the flexible wall being at least partially collapsed to form a male end and the second end of the wall being left uncollapsed to form a female end are clearly structural features of the present invention and are not method limitations as stated by the Examiner. Even if they were, nothing permits the examiner to ignore any express limitations of the claims.

Even if Moyer and Close *et al* were combined, the combination does not include a resiliently flexible wall at least partially collapsed at a first end and therefore fails to teach or suggest all elements of the claims. Neither the core material 40 nor the outer jacket or wall 42 of Close *et al* is collapsed in any way. Duplicating the Close *et al* construction in Moyer (as

described by the examiner) would be merely involve displacing the tabular core with respect to the jacket, something that cannot actually be done with the knitted resilient wire core and braided fiberglass outer jacket of Meyer. Even if it could be done, neither the tubular core 90 or tubular outer jacket of Moyer would need to be collapsed or even partially collapsed as recited in claim 1. At most, the outer jacket is receded from the exposed core.

Furthermore, the combination would fail to disclose:

... the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings.

Nowhere in either Moyer or Close *et al* is a joint being held together by fasteners immediately adjoining each of the first and second ends of the wall received in two space openings disclosed. The clips 10 in Moyer are arranged only according to the arrangement of the holes 160 and the oven door 150 without regard to location of a joining between two ends of the gasket. Close *et al* only discloses a sleeve 46 for strengthening the joining 44 by wrapping the sleeve 46 around the joining 44 of the gasket (col. 3, line 67- col. 4, line 1) or applying an adhesive (col. 5, lines 40-42). Thus, claim 1 is further patentable because the combination of Moyer and Close *et al* does not show or suggest the above-identified feature of claim 1.

### **Telephone Interviews**

On or about October 27, 2005, Examiner Patel telephoned the undersigned representative to discuss a possible amendment to the claims which Examiner Patel said would permit the Pre-Appeal Brief Review panel to allow the claims of the present application. In particular, the Examiner stated that the panel would allow the claims if claim 1 were amended to add to line 8 the phrase, “extending beyond the first end of the tubular member and” so that claim 1 would read, in pertinent part: “the first end of the flexible wall extending beyond the first end of the tubular member and being at least partially collapsed to form a male end . . . .”

On November 1, the undersigned representative spoke with Examiner Patel again and accepted the proposed amendment offered by Examiner Patel. The undersigned representative did so thinking that there was, in fact, written disclosure in the specification describing the

configuration referred to by the panel in the proposed amendment to claim 1. However, after the November 1 conversation, the undersigned representative went back and reviewed the specification for a written description which would support the proposed claim language. Being unable to find any such written description, the undersigned representative called back Examiner Patel that day and stated to him that given the lack of express disclosure of the embodiment of amended claim 1 in the written specification and actual disclosure effectively to the contrary, that the applicant could not accept the proposed amendment.

On November 1, Examiner Patel stated he would try to have the first notice of the panel withdrawn but apparently was unable to do so. As a result, a first notice of the panel was mailed on November 7, 2005 indicating that the application was allowable. Three days later, on November 10, 2005, a second notice was mailed indicating that all the claims remain rejected.

On December 5, 2005, the undersigned representative called Examiner Patel to discuss the possible allowance of at least claim 12, which was rejected with claims 1-5, 10, 11, 13 and 14 as being unpatentable over Moyer U.S. Patent No. 5,205,075 ("Moyer") in view of Close *et al.* U.S. Patent No. 4,156,533 ("Close *et al.*"). The undersigned representative proposed filing a Request for Reconsideration with claim 12 as the only independent claim. However, on reflection, the undersigned representative called Examiner Patel back and informed him that this Request For Continued Prosecution is being filed.

#### **Further grounds for reconsideration of the rejections of Claim 1**

In proposing the above described amendment for claim 1, the panel interpreted Figs. 12 and 13 of the present application as providing support for the proposed amendment language that the flexible outer jacket had to extend beyond the end of the tubular resilient core at the first end of the gasket to permit the depicted collapse at the first end to form the depicted male end of the gasket. While such a construction might be implied in trying to interpret the figures, the express language of the specification states that "...the device 10 (can) be cut from a continuous length of multilayer tubing before or after the (securement) member 19 is engaged with the device." (Page 6, lines 17-18, present application.) In fact, commercial products of the assignee are made by cutting the devices from continuous lengths of multilayer tube after the securement member has been attached to collapse the continuous length of tubing along its length. My Declaration

under 37 C.F.R. § 1.132 accompanies this Preliminary Amendment to present a sample of the commercial gasket made by the assignee according to the invention of the present application, cut from a continuous lengths after the securement member has been attached along the continuous lengths.

It is respectfully submitted that in addition to all of the arguments previously presented, the mistaken belief of the panel that the first end of the core had to be terminated short of the first end of the outer jacket so as to collapse the first end of the outer jacket as shown in the figures is further evidence of the non-obviousness of the claimed construction. Accordingly, reconsideration and withdrawal of the rejections of claim 1 are again requested.

**New claims 17-30**

New dependent claim 17 is supported by the language of the specification, particularly page 4, lines 3-5, and Figs. 2-3.

New independent claim 18 and dependent claims 19-21 are directed to the construction of the male ends of the gaskets of the present invention. Claim 18 is based upon previously presented claim 16 but omits from that claim the original language from the end of claim 1 of "... the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings." Neither of the references relied upon by the examiner for teaching a "male end" to a gasket, Reinvaldt or Close *et al*, discloses or even suggests the provision of a securement to maintain the "male end" of either of those cited references in an at least partially collapsed condition within the uncollapsed female end of the flexible wall.

New dependent claim 19 is based upon Figs. 12 and 13 and the specification at page 6, lines 12-16.

New dependent claim 20 is based directly on original claim 5 and calls for the flexible wall to comprise a tubular, resilient core and a flexible outer jacket.

New dependent claim 21 calls for at least the flexible outer jacket portion of the flexible wall to be at least partially collapsed at the first end by the securement to form the male end. The securement and partially collapsed outer jacket and resilient core are depicted in original Figs.



12 and 13 and at least further suggested by the language at page 6, lines 17-18 calling for the devices of the present invention to be cut from continuous lengths of multilayer tubing after the securement is engaged to the device.

First, with respect to claim 18, Close *et al* does not disclose or suggest an at least partially collapsed wall defining the male end of any gasket as is set forth in claim 18. As was pointed out above with respect to the rejection of claim 1, the “male end” of Close *et al* is formed by extending the core beyond the adjoining end of the outer jacket. Neither the jacket nor the core of Close *et al* is collapsed in any way at either end. Even Reinvaldt does not characterize its “entering ends F” as being partially collapsed. Rather, it just states that the entering ends F are “swaged down somewhat” which indicates a reduction in size but not a collapse or even a partial collapse.

Second, neither Close *et al* nor Reinvaldt discloses or suggests the provision of a securement maintaining the first end of the flexible wall in the at least partially collapsed condition.

Finally, neither Close *et al* or Reinvaldt discloses or suggests a securement let alone the extension of the flexible wall (claim 19) beyond anything that might be argued to be a securement at the male end of the gasket or the partial collapse in outer jacket covering a resilient case.

New independent claim 22 is based upon original claim 12 but omits from that claim the original language from the end of claim 1 of “... the joint being held together by the fasteners immediately adjoining each of the first and second ends of the wall received in two of the spaced openings.” Claim 12 calls for “...the second end of the outer jacket extends beyond an end of the core at the second end of the flexible wall and is turned in upon itself.” The requirement of original claim 12 is nowhere addressed in any of the examiner’s prior rejections and is neither taught nor suggested by the relied upon Moyer and Close *et al* or either of the Reinvaldt and Weil cited references. The construction is shown in the enclosed gasket sample.

**CONCLUSION**

In view of the above remarks, reconsideration and withdrawal of the rejections of claims 1-16, examination of new claims 17-30 and allowance of the application and all claims 1-30 are respectfully requested.

Respectfully submitted,

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